

REMARKS

In the Office action mailed July 28, 2005, the examiner rejects claims 1-10, 15-29, 33-43, 47, 48, and 51-56. This reply amends claims 1, 15, 21, 34, 35, 48 and 51-56 and adds claims 57-59. Thus, claims 1-10, 15-29, 33-43, 47, 48, and 51-59 are pending and under consideration.

I. Response to § 103 rejections

The examiner rejects claims 1-10, 15-29, 33-43, 47, 48, and 51-56 under 35 U.S.C. § 103(a) as unpatentable over WIPO Published PCT Application No. WO 98/43183 ("Legall") in view of U.S. Patent No. 6,643,641 ("Snyder"). These rejections are respectfully traversed for the following reasons.

A. Prior art fails to disclose all claim limitations

The rejections are improper because Legall and Snyder, taken individually or in combination, fail to teach or suggest all the features of the claims.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.

M.P.E.P. § 2143.03.

Legall discusses an electronic program guide having an integrated Web browser (see Figure 2). Further, Legall discusses a search tool. The search tool allows user to search the contents of internal and external resources. Further, the search tool allows users to access Web search engines such as the Yahoo search engine (see column 6, lines 2-15). Legall also discusses a "power search tool" that allows users to search all of these resources at the same time. After a user conducts a search, the results of the search are displayed in the Audio/Video Window shown in Figure 2. The system displays the results of the Web search in the browser window 210, while the results of searching the internal and external databases are displayed in the electronic program guide shown in the upper right window (see Figure 3A, part 320).

Legall discusses only a single type of search. Specifically, Legall discusses searching databases. No other types of searches are discussed in Legall.

In contrast to Legall, the method of claim 21 comprises two different types of searches. First, the method searches a data store destination for locating information. Second, the method searches the locating information. This reply amends the claims to emphasize the occurrence of

two different types of searches.

Legall does not teach anything comparable to the second search performed by the method of claim 21. Furthermore, Snyder also does not teach anything comparable to the second search recited in the method of claim 21. As neither reference teaches this feature, the references, when viewed together, do not teach or disclose all the features of claim 21.

Independent claims 1, 15, 21, 34, 35, 51-56 all recite a feature comparable to the feature of claim 21 discussed above. Therefore, Legall in view of Snyder does not render these claims unpatentable for reasons comparable to the reasons discussed above. Claims 2-10, 16-20, 22-33, 36-43, and 47 are not unpatentable over Legall in view of Snyder at least because they depend upon one of the claims discussed above.

B. Improper rational for combining references

The rejection is also improper because the source of the rational comes from the present application's specification. According to section 2143.01 of the M.P.E.P.,

[t]here are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.

MPEP § 2143.01.

The Office action explains that one would have modified Legall in view of Snyder "because that would have allowed users of Legall to specifically search file extensions and associated data categories, as a result search results appears on the users browser include links to the web pages."

This rational cannot have come from Snyder. Snyder discusses an improvement to an Internet search engine. This improvement is storing small "snapshot" images of web pages. When a user uses the search engine, these snapshots get displayed on the search result screen next to their corresponding URLs (see Abstract). When the system of Snyder creates snapshots from Web pages, the system suppresses and ignores audio and video files associated with the Web page (see column 24, lines 47-49). The system performs this suppression by analyzing file extensions.

Nowhere does Snyder teach or suggest anything similar to the rational articulated by the examiner. Snyder discusses analyzing file extension only for the purpose of suppressing and ignoring audio and video files and not for any other purposes.

Neither Legall, Snyder, nor any other proper sources disclose the rational cited by the examiner. Thus, the only possible source of the rational relied upon by the examiner is the present application's specification. Because the examiner relies upon the applicant's own disclosure for a rational to combine, the rejection employs improper hindsight reasoning.

II. New claims 57-59

This reply adds claims 57-59. Claim 57 recites a feature comparable to the feature of claim 21 discussed above. Therefore, this claim is not unpatentable over Legall in view of Snyder for reasons comparable to the reasons discussed above. Claims 58 and 59 are not unpatentable over Legall in view of Snyder at least because they depend upon claim 57

III. Conclusion

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with the filing of this reply, please charge them to Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: Nov. 23, 2005

By: Skip Gain

Edward "Skip" Gain
Registration No. 55,917

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500